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10/553,251

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Georg Roeder

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EXAMINER

DOAN, ROBYN KIEU

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

05/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/553,251 | <b>Applicant(s)</b><br>ROEDER, GEORG |  |
|                              | <b>Examiner</b><br>Robyn Doan        | <b>Art Unit</b><br>3732              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 57-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/6/05; 8/11/06</u>  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 57, 58, 60, 61, 63, 77, 103-106 are rejected under 35 U.S.C. 102(b) as being anticipated by Karl (EP 0038524A2).

Karl discloses an applicator (figs. 2, 5) comprising a holding portion (1) and a hollow applicator portion (3) being formed by a casing which at least partially encloses a hollow space, a connecting layer being a mixing layer between the applicator portion and the holding portion, wherein the connection layer having a positively locking connection (9, fig. 5) between the applicator portion and the holding portion; the applicator having a plurality of structure elements (4) and being made of soft plastic material (page 6, lines 19-23) and the holding portion being made of harder plastic material. With regard to limitations “wherein the holding portion does not form a core extending into the hollow applicator portion”, Applicant is noted that the device of Karl is the same as the final product of the instant invention, therefore it meets the claimed language; further, if Applicant intended to claim the process of making the device, Applicant is noted that such process step is not given patentable weight in an article

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claim. In regard to claims 103-106, Karl discloses the process of making the device as claimed in claims 103-106.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 59, 62, 64-76, 78-101, 111, 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karl in view of Spatz (USP 4,635,659).

Karl discloses the essential claimed invention as discussed above except for the applicator portion tapers away from the holding portion and being made of rubber, the holding portion being made of thermoplastic material; the mixing layer being between 1/100mm and several 1/10mm thick; the applicator portion being bristles, slats, knobs, prongs extend perpendicular to the applicator surface between .1mm to 1mm and having a diameter between .4mm to .6mm; the casing having a thickness between .8mm and 1.3mm with a hardness between 5 to 45 Shore A. Spatz discloses an applicator head (fig. 2) being made of rubber material (col. 4, lines 35-37). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the material of Spatz into the applicator of Karl for the intended use purpose. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the mixing layer being between 1/100mm and

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several 1/10mm thick; the applicator portion being bristles, slats, knobs, prongs extend perpendicular to the applicator surface between .1mm to 1mm and having a diameter between .4mm to .6mm; the casing having a thickness between .8mm and 1.3mm with a hardness between 5 to 45 Shore A, since such a modification would have involved a mere change in the size and shape of the known component. A change in shape is generally recognized as being within the level or ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). And it would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ a thermoplastic material for the holding portion, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claim 102, 107-110, 113-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karl in view of Hand (USP 2,140,009).

With regard to claim 102, Karl discloses the essential claimed invention as discussed above except for the holding portion having metal. Hand discloses a cosmetic applicator (fig. 1) comprising a holding portion (16) being made of metal (col. 2, line 12); the device further having a cap (8). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the holding portion of Karl with the metal material as taught by Hand as an alternative way of forming the holding portion. In regard to claims 113-116, Karl in view of Hand discloses the method recited in the claims during normal operational use of the device. In regard to claims

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107-110, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to inject the applicator portion onto the holding portion at a temperature between 30°C to 80°C. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct temperature between 30°C to 80°C, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morrison is cited to show the state of the art with respect to an applicator with a soft material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/  
Primary Examiner, Art Unit 3732